

Application Serial No.: 09/827,096
Reply to Office Action dated May 20, 2005

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-8 and 19-26 are presently active in this case, Claims 1 and 3 having been amended in a non-narrowing manner, Claims 9-18 having been canceled without prejudice or disclaimer as being drawn to non-elected species, and Claims 19-26 having been added by way of the present Amendment.

Claims 3-8 have been withdrawn from consideration.

Newly added Claims 19 and 20 are drawn to the elected species.

In the outstanding Official Action, Figure 63C was objected to for missing reference character “3” at the end of the leader-line corresponding thereto. Submitted concurrently herewith is a Replacement Sheet that includes changes to Figure 63C to include reference character “3” at the end of the leader-line corresponding thereto. Accordingly, the Applicant requests the withdrawal of the objection to Figure 63C.

The title of the invention was objected to as not being descriptive. The title has been changed to “IMAGING DEVICE HAVING AN IMAGING ELEMENT MOUNTED ON A SUBSTRATE.” Accordingly, the Applicant requests the withdrawal of the objection to the title.

The disclosure was objected to for a minor informality. The specification has been amended as suggested on page 3, paragraph 4, of the Official Action. The Applicant therefore requests the withdrawal of the objection to the disclosure.

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Claims 1 and 2 were rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al. (U.S. Patent No. 5,040,069). For the reasons discussed below, the Applicant respectfully traverses the anticipatory rejection.

In the Office Action, the Matsumoto et al. reference is indicated as anticipating each of Claims 1 and 2. However, the Applicant notes that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Matsumoto et al. reference clearly does not meet each and every limitation of the independent Claim 1.

Claim 1 of the present application recites an imaging device including integrally an imaging element to be mounted on a substrate and an optical element having an imaging lens section for providing a light-receiving surface of the imaging element with optical information. The substrate has an opening section. The imaging element is fastened on the substrate so as to close the opening section with a surface including the light-receiving surface. And, the optical element is in contact with the upper surface of the imaging element by way of the opening section. The Matsumoto et al. reference does not disclose an optical element that is in contact with an upper surface of an imaging element, as recited in Claim 1 of the present application.

The Official Action cites the thin film substrate (103) of the Matsumoto et al. reference for the teaching of the substrate of Claim 1 of the present application, and the solid image pickup device (104) for the teaching of the imaging element of Claim 1. The Matsumoto et al. reference describes, with reference to Figure 7, a solid image pickup

assembly (101) including a transparent support plate (102), a flexible thin film substrate (103), and a solid image pickup device (104) mounted on the thin film substrate (103). The thin film substrate (103) blocks light except in the area of a rectangular opening (105). The solid image pickup device (104) is mounted on a rear side of the thin film substrate (103), and the transparent support plate (102) is provided at a front side of the substrate (103) in between the substrate (103) and an optical unit (labeled as 12 and 13 in Figure 2).

The solid image pickup device (104) is clearly spaced apart from the transparent support plate (102) by the substrate (103), and thus the solid image pickup device (104) is clearly spaced apart from the optical unit by both the support plate (102) and the substrate (103). While a cross-sectional view is not depicted for the embodiment of Figure 7, the cross-sectional view in Figure 1 of the first embodiment clearly shows not only the spacing between the solid image pickup device (19) and the optical unit caused by resin (23), but also an air pocket provided between resin (23) and the optical unit. The embodiment of Figure 7 would include a larger air pocket in the area within opening (105). Accordingly, the Applicant respectfully submits that no portion of the optical unit of the Matsumoto et al. reference is in contact with a surface of the solid image pickup device (104).

Webster's II, New College Dictionary defines "contact" as "1. The touching of two objects or surfaces. 2. The state of being in communication <in *contact* with their relatives> 3. One who might be of use : CONNECTION <political *contacts*>...." MPEP 2111 notes that "the pending claims must be given their broadest reasonable interpretation consistent with the specification." MPEP 2111 further notes that "[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in

the art would reach.” One of skill in the art would clearly understand the first definition as being the most appropriate in the present instance where structural objects and surfaces are being positionally defined. The Applicant submits that clearly no portion of the optical unit of the Matsumoto et al. reference touches a surface of the solid image pickup device (104). The Official Action suggests that since light can travel through the optical unit to the solid image pickup device (104), then these features are in communication with one another in the sense of the second definition above. However, the issue is not whether light is in communication with either of these features. The fact that particles of light may be in contact with the optical unit as they pass therethrough, and that those light particles may later be in contact with the solid image pickup device (104) as they pass therethrough, is irrelevant and does not mean that the optical unit in and of itself is in contact or communication (in the sense defined above) with the solid image pickup device (104). Such an interpretation would not be reasonable, as it is not consistent with the specification and as it is not consistent with the interpretation that those skilled in the art would reach.

Accordingly, the Applicant respectfully submits that the Matsumoto et al. reference does not disclose an optical element that is in contact with an upper surface of an imaging element, as recited in Claim 1 of the present application. Thus, the Applicant respectfully requests the withdrawal of the anticipation rejection of Claim 1.

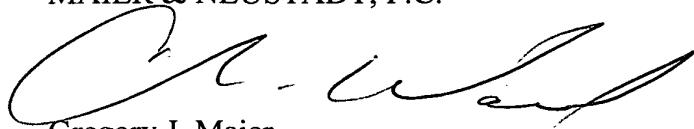
The dependent claims are considered allowable for the reasons advanced for Claim 1 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of Claim 1.

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Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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IN THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 63C. This sheet, which includes Figs. 61A, 61B, 62A, 62B, 62C, 62D, 63A, 63B, and 63C, replaces the original sheet including Figs. 61A, 61B, 62A, 62B, 62C, 62D, 63A, 63B, and 63C.

Attachment: Replacement Sheet